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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,194	10/19/2001	Christoph Heckenkamp	BEU/HECK3001	7979

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EXAMINER

ASSAF, FAYEZ G

ART UNIT PAPER NUMBER

2872

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,194

Applicant(s)

HECKENKAMP ET AL.

Examiner

Fayez G. Assaf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 20-77 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 33, 36-48 and 60-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10, 13-18, 20-32, 34, 35, 49-59 and 77 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/023,430.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Correction***

There was a typographical error in the listing of the claims rejected under 35 U.S.C. 102(b) in Office Action mailed on 8/19/2002. Namely, claims 10, 13, 14 and 34 were not listed, and claim 36 was erroneously included. This error has no effect on the substance of the Office Action, since claims 10, 13, 14 and 34 were examined on the merit, and addressed in the body of the Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-10, 13-18, 20-25, 27, 28, 29, 31, 34, 35, 49-52, 54-59 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Sander (US 4,629,647).

Regarding claims 8, 14, 16, 17, 22-25, 27, 28, 31, 34-35, 49-52, 55-57, 59 and 77, Sander discloses a data carrier (see

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Fig. 2) which is manufactured and thereafter issued for use, the data carrier having a body provided with a multiplayer, optically variable element comprising metal diffraction structures (4 of Fig. 2), the diffraction structures presenting visually recognizable information (line 16 to line 18 of Col. 2), wherein the data carrier is provided with an alteration in a portion of the optically variable element, the alteration comprising a modification of the contour of the diffraction structures (layer having elements 9b's in Fig. 2). The alteration comprising replacing the diffractive structures by non-diffractive structures or partial removal or change of the contour in at least one partial area, or partially removing of at least one layer of optically variable element (see 8b, 9b and 10b of Fig. 2). Additionally, the alteration comprising a coloration of at least one layer of the optically variable element (line 29 to line 33 of Col. 5). It is noted that the optically variable element comprises a metal layer (9b's in the layer are not contiguous, i.e. metal layer being partially removed).

Regarding claim 9, 10, 18, 20, 21, 54, 58 Sander discloses the contour being a line structure provided in the form of positive or negative print (line 48 to line 62 of Col. 8) having a transparent luminescent substance (10b's of Fig. 2),

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and overlapping or in alignment with the variable optical element.

Regarding claim 13, Sander discloses the optical element comprising an at least partly permeable reflective layer (all layers are inherently partly permeable and reflective).

Regarding claim 15, Sander discloses the metal pattern being a grid (line 52 of Col. 8).

Regarding claim 29, Sander discloses the optically variable element comprising a protective colored lacquer (9b's of Fig. 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 26, 30, 32 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sander.

Regarding claims 26, 30 and 53, Applicant is claiming the product including the process of making the alteration by means

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of laser beam, and therefore is of "product-by-process" nature. The courts have been holding for quite some time that: the determination of the patentability of product-by-process claim is based on the product itself rather than on the process by which the product is made. In re Thrope, 777 F. 2d 695, 277 USPQ 964 (Fed. Cir. 1985); and patentability of claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious. Applicant has chosen to claim the invention in the product form. Thus a prior art product which possesses the claimed product characteristic can anticipate or render obvious the claim subject matter regardless of the manner in which is fabricate. A rejection based on 35 USC section 102 or alternatively on 35 USC section 103 of the status is eminently fail and acceptable. In re Brown and Safer, 173 USPQ 685 and 688; In re Pilkington, 162 USPQ 147.

Regarding claim 32, sander discloses the claimed invention except for the metal layer comprising copper, silver or gold. However, such choice of material can be determined by routine experimentation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such materials, since it has been held to be within the general skill

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of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416.

### ***Allowable Subject Matter***

Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11 and 12 are allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest the arrangement of the diffraction structure as set forth in the claimed combination.

### ***Response to Arguments***

Applicant's arguments filed 12/18/2002 have been fully considered but they are not persuasive.

Applicant argues that Sander fails to disclose or suggest alteration of the hologram by modifying a contour of the diffraction structures, because the layer 3a merely covers the diffractive structure, and element 9b does not touch said grating. The Examiner respectfully disagrees, because the layer 10a having certain parts replaced by element(s) 9b is

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interpreted as being the contour. As explained in *Webster's Ninth new Collegiate Dictionary*, contour means "*the general form or structure of something*". Evidently, layer 10a shapes the general form of the grating as transparent portions are replaced by non-transparent element(s) 9b (line 47 to line 62 of Col. 8).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Faye Assaf whose telephone number is (703) 306-5526. The fax number



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for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*FA*

Fayez Assaf

3/19/03

*John Juba*  
**JOHN JUBA**  
**PRIMARY EXAMINER**